

**REMARKS**

Claims 1-38 are pending in the application with claims 1, 36 and 38 as independent.

The disclosure is objected for informalities.

The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter.

The claims are objected to for informalities.

Claims 1-35 and 38 are rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter.

Claims 1-3, 5-11, 14-20, 22-27 and 29-35 are rejected under 35 U.S.C. §102(b) as being anticipated by Baroni et al. ("Wavelength Requirements in Arbitrarily Connected Wavelength-Routed Optical Networks," Journal of Lightwave Technology, vol. 15, No. 2, February 1997, pp. 242-251 (hereinafter referred to as "Baroni").

Claims 36-38 are rejected under 35 U.S.C. §102(b) as being anticipated by Kirby et al. (US Pub. No. 20020120768) (hereinafter referred to as "Kirby").

Claims 4, 12, 13 and 21 are rejected under 35 U.S.C. §103(a) as being unpatentable over Baroni in view of Al-Salameh et al. ("Optical Switching in Transport Networks: Applications, Requirements, Architectures, Technologies, and Solutions," in Optical Fiber Telecommunications IV A Components (Kaminow, I.P., et al., Eds. Academic Press, 2002, pp. 295-373) (hereinafter referred to as "Al-Salameh").

Claim 28 is rejected under 35 U.S.C. §103(a) as being unpatentable over Baroni in view of Weis (US Pub. No. 20030067867) (hereinafter referred to as "Weis").

Each of the various rejections and objections are overcome by amendments that are made to the specification, drawing, and/or claims, as well as, or in the alternative, by various arguments that are presented.

Any amendments to any claim for reasons other than as expressly recited herein as being for the purpose of distinguishing such claim from known prior art are not being made with an intent to change in any way the literal scope of such claims or the range of equivalents for such claims. They are being made simply to present language that is better in conformance with the form requirements of Title 35 of the United States Code or is simply clearer and easier to understand than the originally presented language. Any

amendments to any claim expressly made in order to distinguish such claim from known prior art are being made only with an intent to change the literal scope of such claim in the most minimal way, i.e., to just avoid the prior art in a way that leaves the claim novel and not obvious in view of the cited prior art, and no equivalent of any subject matter remaining in the claim is intended to be surrendered.

Also, since a dependent claim inherently includes the recitations of the claim or chain of claims from which it depends, it is submitted that the scope and content of any dependent claims that have been herein rewritten in independent form is exactly the same as the scope and content of those claims prior to having been rewritten in independent form. That is, although by convention such rewritten claims are labeled herein as having been "amended," it is submitted that only the format, and not the content, of these claims has been changed. This is true whether a dependent claim has been rewritten to expressly include the limitations of those claims on which it formerly depended or whether an independent claim has been rewritten to include the limitations of claims that previously depended from it. Thus, by such rewriting no equivalent of any subject matter of the original dependent claim is intended to be surrendered. If the Examiner is of a different view, he is respectfully requested to so indicate.

#### **Objections to the Specification**

1) The disclosure is objected for minor informalities. The specification is amended to cure the deficiencies indicated by the Examiner. Withdrawal of the objection is respectfully requested.

2) The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. Applicants respectfully disagree.

Pursuant to MPEP §2173.05(e), the mere fact that a term or phrase used in the claim has no antecedent basis in the specification disclosure does not mean, necessarily, that the term or phrase is indefinite. There is no requirement that the words in the claim must match those used in the specification disclosure. Applicants are given a great deal of latitude in how they choose to define their invention so long as the terms and phrases used define the invention with a reasonable degree of clarity and precision. In the instant case, the terms are clear and precise. Therefore, the rejection should be withdrawn.

Regarding the objection to the term “a computer readable medium,” the specification is objected to as failing to provide proper antecedent basis for the phrase “computer readable medium” recited in claim 36. Applicants respectfully disagree. Pursuant to MPEP §2173.02 a claim term that is not used or defined in the specification is not indefinite if the meaning of the claim term is discernible. *Bancorp Services, L.L.C. v. Hartford Life Ins. Co.*, 359 F.3d 1367, 1372, 69 USPQ2d 1996, 1999-2000 (Fed. Cir. 2004) (holding that the disputed claim term “surrender value protected investment credits” which was not defined or used in the specification was discernible and hence not indefinite because “the components of the term have well recognized meanings, which allow the reader to infer the meaning of the entire phrase with reasonable confidence”). In this case “computer readable medium” which is not defined or used in the specification is discernible and hence not indefinite because “the components of the term have well recognized meanings, which allow an artisan of ordinary skill in the art (the reader) to infer the meaning of the entire phrase with reasonable confidence. Therefore, the rejection should be withdrawn. The Examiner is respectfully requested to withdraw the objection.

#### **Objections to the Claims**

Regarding the numerous objections to the claims for lack of antecedent basis (e.g., ‘a, an’ or ‘the,’ the Examiner’s attention is directed to MPEP §2173.05(e), which states: “the failure to provide explicit antecedent basis for terms does not always render a claim indefinite. If the scope of a claim would be reasonably ascertainable by those skilled in the art, then the claim is not indefinite. Further, the Examiner oftentimes requests correction where it is unjustified. For example, the Examiner requested that the phrase “the number” in “the number of demands” be amended to “a number.” However, claim 7 recites: “a number of demands,” which provides antecedent basis for claim 8. Accordingly, Applicants have amended those instances where clear antecedent basis is required. The Examiner is respectfully requested to withdraw the objection.

The Examiner further asserts that the mathematical symbols within an equation are undefined. This represents clear error on the part of the Examiner. Withdrawal of these objections is respectfully requested.

#### **Rejection Under 35 U.S.C. §101**

##### **Claims 1-35 and 38**

Claims 1-35 and 38 are rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. Claim 1 is amended as set forth below.

1. (Currently Amended) A method for quantifying the needs and costs of a network using a global expectation model, comprising:  
determining quantities of required network variables using closed-form mathematical expressions for network-wide expectation values for mean quantities of the required network variables; and  
assessing and designing element feature requirements, product definition, application domains and product and technology road-mapping.

As amended, the claim recites limitations which can only be performed by a machine and which transform the design of the network.

Claim 38 is amended to recite: "The software program product stored on a computer readable medium" which renders the claim patentable under 35 U.S.C. §101.

Therefore, Applicant's claim 1-35 and 38 is allowable under 35 U.S.C. §101. The Examiner is respectfully requested to withdraw the rejection.

#### **Rejection Under 35 U.S.C. §102**

##### **Claims 1-3, 5-11, 14-20, 22-27 and 29-35**

Claims 1-3, 5-11, 14-20, 22-27 and 29-35 are rejected under 35 U.S.C. §102(b) as being anticipated by Baroni. The rejection is traversed.

Anticipation under §102 can be found only when the reference discloses exactly what is claimed. MPEP §2131.03(III). Furthermore, "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Verdegaal Bros. V. Union Oil Co. Of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The anticipation regime announced by the court requires "express" or "inherent" disclosures in a single

prior art as the necessary test to reject a claim during prosecution of an application. The Baroni reference fails to disclose each and every element of the claimed invention, exactly as recited in independent claim 1.

Specifically, the Baroni reference fails to teach or suggest at least:

“assessing and designing element feature requirements, product definition, application domains and product and technology road-mapping.”

As such, independent claim 1 is not anticipated by Baroni and is allowable under 35 U.S.C. §102(b). Since all of the dependent claims that depend from the independent claims include all the limitations of the respective independent claim from which they ultimately depend, each such dependent claim is also allowable over Baroni under 35 U.S.C. 102(b).

Therefore, Applicant’s claims 1-3, 5-11, 14-20, 22-27 and 29-35 are allowable over Baroni under 35 U.S.C. §102(b). The Examiner is respectfully requested to withdraw the rejection.

#### **Claims 36-38**

Claims 36-38 are rejected under 35 U.S.C. §102(b) as being anticipated by Kirby. The rejection is traversed.

The Kirby reference fails to disclose each and every element of the claimed invention, exactly as recited in independent claim 36.

Specifically, the Kirby reference fails to teach or suggest at least:

“assessing and designing element feature requirements, product definition, application domains and product and technology road-mapping.”

As such, independent claim 36 is not anticipated by Kirby and is allowable under 35 U.S.C. §102(b). Furthermore, independent claim 38 recites relevant limitations similar to those recited in independent claim 36 and, as such, and at least for the same reasons as discussed above, independent claim 38 also is not anticipated by Kirby and is allowable under 35 U.S.C. §102(b). Since all of the dependent claims that depend from the independent claims include all the limitations of the respective independent claim from which they ultimately depend, each such dependent claim is also allowable over Baroni under 35 U.S.C. §102(b).

Therefore, Applicant's claims 36-38 are allowable over Kirby under 35 U.S.C. §102(b). The Examiner is respectfully requested to withdraw the rejection.

**Rejection Under 35 U.S.C. §103(a)**

**Claims 4, 12, 13, 21 and 28**

Claims 4, 12, 13 and 21 are rejected under 35 U.S.C. §103(a) as being unpatentable over Baroni in view of Al-Salameh. Claim 28 is rejected under 35 U.S.C. §103(a) as being unpatentable over Baroni in view of Weis. The rejections are traversed.

Each of these grounds of rejection applies only to dependent claims, and each is predicated on the validity of the rejection of independent claim 1 under 35 U.S.C. §102(b) over Baroni. Since the rejection under 35 U.S.C. §102(b) over Baroni has been overcome, as described hereinabove, and there is no argument put forth by the Office Action that the additional references supply that which is missing from Baroni to render the independent claims anticipated, these grounds of rejection cannot be maintained.

Therefore, Applicant's claims 4, 12, 13, 21 and 28 are allowable over Baroni in view of Al-Salameh or Weis under 35 U.S.C. §102(b). The Examiner is respectfully requested to withdraw the rejection.


**Conclusion**

It is respectfully submitted that the Office Action's rejections have been overcome and that this application is now in condition for allowance. Reconsideration and allowance are, therefore, respectfully solicited.

If, however, the Examiner still believes that there are unresolved issues, the Examiner is invited to call Eamon Wall at (732) 842-8110 X120 so that arrangements may be made to discuss and resolve any such issues.

Respectfully submitted,

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